
Nos. 22495 and 22495-A

IN THE
United States Court of Appeals
FOR THE NINTH CIRCUIT

PROLER STEEL CORPORATION, *Appellant*,

v.

LURIA BROTHERS & COMPANY, INC.
and LIPSETT STEEL PRODUCTS, INC., *Appellees*.

REPLY BRIEF FOR APPELLANT

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REPLY BRIEF FOR APPELLANT

I.

SUMMARY OF THE ARGUMENT

A process patent may not be held to be invalid merely because equipment known in the prior art may be used to practice the process.

In the alleged defense of "aggregation" the law is clear that appellees have the burden of establishing (1) that all of the *steps* in Claim 9 were old at the time of the invention, and (2) that the combination of the steps did not produce any "new, useful, and unexpected result." The record in this case clearly raises genuine issues of material fact on both of these matters.

Appellees have not commented on any of the six *factual* tests laid down by the Supreme Court in *Graham v. Deere*, 383 U.S. 1, 15 L.Ed.2d 545 (1966) as material to the alleged defense of "obviousness." The record in this case raises genuine issues of material fact on each of these tests.

It is immaterial what apparatus appellees use to perform the third step of Claim 9 so long as they perform the step. Their own officers and employees admit that in appellees' third step they individually compact the pieces, which is the third step of Claim 9 of the Patent.

There are genuine issues of material fact on infringement as to (1) whether appellees' act of running previously shredded ferrous scrap through their hammer mill constitutes "individually compacting and balling up the pieces of the more ferrous bearing shredded material to densify it while maintaining the individuality of the separate pieces, whereby a fluent mass is obtained"; (2) whether the language in Claim 9 "while maintaining the individuality of the separate pieces" was intended by the patentee to distinguish over the prior art practice of baling or was intended by the patentee to exclude any subdivision of the pieces; and (3) whether appellees in performing the third step of their process are merely following the prior art process of a closed circuit grinding of ores and minerals.

Appellees do not deny the existence of a genuine issue of material fact on whether Claim 9 covers the invention disclosed in the original patent. The district court erred in deciding this fact issue on summary judgment.

The record before the patent office shows conclusively that it was error without deceptive intention for Sam Proler to fail to claim the purifying step more broadly in his original patent and that Mr. Proler's reissue oath described the error. At the very least, genuine issues of material fact are raised on both inquiries, and further, on whether, without the oath, the commissioner had sufficient evidence before him to find the error.

II.

ARGUMENT

A. VALIDITY OVER PRIOR ART

1. Appellant's Patent Covers a Process, Not Equipment.

Appellees' entire argument on validity is based on the clearly erroneous assumption that if known equipment may be used to perform the steps of Claim 9, the claim is invalid.

In *Expanded Metal Company v. Bradford*, 214 U.S. 366, 53 L.Ed. 1034 (1909), there was involved a process for making expanded metal, using knives, the age-old function of which was to cut, and "mechanism for the shifting of the sheet and of the knives" which was already in use in machines for expanding metal. In upholding the patent on the process the Supreme Court held that "The important thing in this patent is a method of procedure, not the particular means by which the method shall be practiced". *Expanded Metal*, supra, at 381.

Expanded Metal definitely settled the law to the effect that "operations which consist entirely of mechanical transactions, but which may be performed by hand or by any of several different mechanisms or machines" may be the subject of a process patent. *Deller's Walker on Patents*, Second Edition, §15, p. 106.

Claim 9 does not describe any machine or the function of any machine. It sets out three steps to be applied to a particular material in order to produce a particular product. Several means may be contemplated for the accomplishment of each step. In the first step the material is sized. To accomplish this step one might use a cutting torch, a shear or a hammer mill. In the second step the material is separated from non-ferrous contaminants. To accomplish this step one might use hand picking, a kiln,

a trommel, a screen, or a magnetic pulley. In the third step the material is densified by individual compaction of the pieces. To accomplish this step one might use a hammer mill operating on the individual pieces (which have already been sized), a hammer, a hand tamp, or a rolling mill. In suggesting a hammer mill to accomplish the first step, a magnetic pulley to accomplish the second step, and rolls to accomplish the third step, appellant was merely following the statute which requires that the patentee set out the best mode contemplated of carrying out his invention. 35 U.S.C. §112.

Sam Proler, in the first trial of his invention, used a hand tamp to compact the individual shredded pieces. As of this time he had not even thought of rolls as a better instrumentality for accomplishing this step (Proler deposition, p. 171). The significance of this fact is that his invention was a series of *steps* to be performed on the material, not the functions of the machines which he later decided to employ.

In the words of the Supreme Court in *Waxham v. Smith*, 294 U.S. 20, 22, 79 L.Ed. 733 (1935):

“A method, which may be patented irrespective of the particular form of the mechanism which may be availed of for carrying it into operation, is not to be rejected as ‘functional,’ merely because the specification shows a machine capable of using it.”

The only case cited by appellees involving a process patent is *Hunter Douglas Corp. v. Lando Products*, 215 F.2d 372 (9th Cir. 1954), wherein a summary judgment was not in issue. The opinion in *Hunter* discloses that in the prior art the same *steps* as those in the patent had been combined *in the same sequence*, treating the *same material*, for the *same purpose*, and had achieved the *same result*. The decision obviously has no materiality to this case.

2. Fact Issue on Whether All of the Steps in Claim 9 Were Old.

Appellees have not denied that their first burden in upholding summary judgment on the defense of "aggregation" is to show that no fact issue is raised on whether all the steps of claim 9 were old. *Coleman Co. v. Holly Mfg. Co.*, 233 F.2d 71, 78 (9th Cir. 1956).

Appellees have failed to show there is no fact issue on whether individual compacting of shredded scrap was new or old at the time of Sam Proler's invention. They have instead dwelt on the fact that rolls were used for other purposes before the invention. This is beside the point. *Carnegie Steel Co. v. Cambria Iron*, 185 U.S. 403, 424, 425, 46 L.Ed. 968 (1902):

"A mechanical patent is anticipated by a prior device of like construction and capable of performing the same function; *but it is otherwise with a process patent*. The mere possession of an instrument or piece of mechanism contains no suggestion whatever of all the possible processes to which it may be adapted. . . . If the mere fact that a prior device might be made effective for the carrying on of a particular process were sufficient to anticipate such process, the absurd result would follow that, if the process consisted merely of manipulation, it would be anticipated by the mere possession of a pair of hands." (Emphasis added).

See also *Elrick Rim Company v. Reading Tire Machinery Co.*, 264 F.2d 481 (9th Cir. 1959).

The only evidence appellees rely on for their proposition that step 3 of claim 9 was old is the testimony of Sam Proler with respect to flattening whole tin cans in rollers. This previous practice of Mr. Proler is not the same as step 3 of claim 9, because the evidence (Proler affidavit, Ex. B) shows (a) the rolls operated on tin cans,

whereas step 3 deals with processing shredded pieces of scrap; (b) the flattening of the cans was done merely to facilitate shipment before sending the cans to a plant for processing, whereas step 3 of claim 9 is an integral step in the patented process; (c) after being flattened (merely for shipment), the cans were processed as a product for use in the copper mines, where the end product was intentionally left ragged or fluffy for use as precipitation iron, whereas in the patented process the product is an entirely different one, which is purposely densified for use as scrap in steel mills; and (d) in the Proler patent it is stated that tin plate (tin cans) is undesirable in the process (R. 338).

The question of whether Mr. Proler's use of rolls to flatten tin cans for shipment is the same as step 3 of claim 9 in the Proler process is one of fact, as clearly held in *Cee-Bee Chemical Co. v. Delco Chemicals*, 263 F.2d 150 (9th Cir. 1958), wherein summary judgment for the defendant was reversed:

“Appellee argues in effect that a ‘soapy’ spray and a ‘water-rinsable, solvent-miscible’ spray are one and the same. This may be true, but to so decide necessitates the determination of a *question of fact* which appellant disputes, as revealed by the Whitcomb affidavit.” *Cee-Bee*, supra, at p. 153. (Emphasis added).

3. Fact Issue on Whether the Process Produced Any New, Useful or Unexpected Result.

Appellees have not denied that in order to sustain the summary judgment on the defense of “aggregation” they have the *additional* burden of showing there is no fact issue on whether there was anything new, useful, or unexpected produced as a result of the combination of the three steps in the Proler patent, *Coleman*, supra, at 78.

Appellees have failed to meet that burden. They haven't even referred in their brief to the evidence from their own officials and employees to the effect that the product which was the result of that combination was new, useful, unexpected, even "revolutionary". Appellees do not dispute that the process invented by Mr. Proler produced for the very first time a fluent mass of clean shredded scrap having a density high enough for use by the steel mills.

Appellees say the product is now in the public domain. But it is undisputed that the product did not exist before Sam Proler's invention. The product of a process can constitute the new, useful, and unexpected result. *National Latex Products Company v. Sun Rubber Company*, 274 F.2d 224, 239 (6th Cir. 1959). In the *National Latex* case the patent did not cover the product.

4. Factual Tests on Obviousness.

Appellees don't even argue that it was obvious, at the time of the invention, to *combine the three steps* in the Proler process to obtain a pure, dense, steel scrap in flowable form. They dodge this argument, which is the true legal test (*U. S. v. Adams*, 383 U.S. 39, 15 L.Ed.2d 572 (1966)), because the evidence material to the six *factual* tests on obviousness laid down by the Supreme Court in *Graham v. Deere*, *supra*, as outlined in appellant's principal brief, is overwhelmingly in appellant's favor on the issue of obviousness of the invention.

An excellent illustration of the *Graham v. Deere* tests may be found in the recent case of *National Dairy Products Corp. v. Borden Co.*, 157 U. S. P. Q. 227 (7th Cir. 1968). The court there stated that it was a strong indication of non-obviousness that there had been prior unsuccessful attempts to solve the long-felt need, that

the patented process successfully met the need, and that the individual steps were long available but no one had discovered the process until the patentee. (*National Dairy*, supra, at 230, 231).

Appellees' argument on obviousness is only that it was obvious that the shredded material would be compacted when it was passed between rolls. But the question is whether it was obvious to *combine the steps*, not whether, once they were combined, those skilled in the art would know what result to expect. *U. S. v. Adams*, supra. Viewed after the event, many patentable inventions seem obvious. *National Sponge Cushion Co. v. Rubber Corp. of Cal.*, 286 F.2d 731, 735 (9th Cir. 1961); and *Neff Instrument Corp. v. Cohu Electronics, Inc.*, 298 F.2d 82, 88 (9th Cir. 1961). ". . . [T]he fact that the solution to a problem is simple, or appears so, when viewed in retrospect, does not mean the solution was obvious when it was made. . . ." The courts must "guard against the exercise of hindsight in assessing the obviousness of a given improvement in the art." *National Dairy*, supra, at 231.

The prior art now cited by appellees as being grounds for summary judgment for obviousness discloses nothing that was not disclosed in the prior art considered by the Patent Office. The Gregg patent was the basic reference considered by the Patent Examiner (R. 388, 399, 440, 507), and the Near patent* (Ex. C), also considered by the Examiner (R. 388, 507), shows crushing of ferrous scrap by a crushing belt 11 and a compressor roll 77 *before* the material is fed into a hammer mill for shredding. The presumption of validity of an issued patent is strengthened when the closest prior art was considered by the Patent Office. *Neff Instrument*, supra, at 86, 87.

* Both of these patents were brought to the attention of the Examiner by the applicant (R. 384).

5. Summary of Fact Issues on Validity Over Prior Art.

It is clear that the evidence in the record raises genuine issues of material fact on the defense of "aggregation" as follows:

a) Whether all of the steps of claim 9 were old, i.e., whether Sam Proler's flattening of tin cans was the same as step 3 of claim 9 and, if so:

b) Whether the process of claim 9 *as a whole* produced a result which is "new, useful, and unexpected".

It is further clear that the evidence in the record raises genuine issues of material fact on each of the six *factual* tests on non-obviousness laid down by the Supreme Court in *Graham v. Deere*, i.e.: (a) whether there was prior art showing the third step of claim 9 (Appellees do not deny the *combination* is novel); (b) whether there were differences between the tin can operation and the third step of claim 9; (c) whether a person of ordinary skill in the art would have combined the steps of claim 9; (d) whether the process was a commercial success; (e) whether there was a long felt and unsolved need; and (f) whether others skilled in the art failed to solve the problem.

B. INFRINGEMENT

1. Appellant's Patent Covers a Process, Not Equipment.

Appellees wrongfully interpret the third paragraph of 35 U.S.C. §112 in furtherance of their attempt to concentrate on the *equipment* suggested as useful to perform the process, rather than on the *steps* of the process.

The third paragraph of 35 U.S.C. §112, as applicable to a process patent, reads as follows:

“An element in a claim for a combination may be expressed as a means or STEP for performing a specified function without the recital of structure, material or ACTS in support thereof, and such claim shall be construed to cover the corresponding structure, material or ACTS described in the specification and equivalents thereof.” (Emphasis added).

STEP goes with ACTS and is unrelated to “structure” and “material”. It has been uniformly held for at least the past 90 years that in considering whether a method claim is infringed, it is immaterial what apparatus is disclosed by the patent and used by defendant. Only the acts are to be compared. *Cochrane v. Deener*, 94 U.S. 780, 787, 24 L.Ed. 139 (1877), *Sbicca-Del Mac v. Milius*, 145 F.2d 389, 397 (8th Cir. 1944).

In the case at bar the function is densification, and the claim *does* recite the act in support thereof, namely, individually compacting and balling up. Therefore there is no need to refer to the description to determine what act Proler disclosed to achieve densification. However, if one did turn to the description he would find that Proler states that to densify the material it is to be individually compacted (R. 338, col. 2, lines 62, 63). Since defendants admittedly perform the identical act of individually compacting, there is no need to consider the question of what other acts whose function is densification might be equivalent to individual compacting within the scope of the patent.

Under *Cochrane* and *Sbicca-Del Mac*, supra, it is clear that the third step of claim 9 may not be limited to the function of rolls or their equivalent. Appellees have cited no law to the contrary.

The erroneous construction placed on Section 112 by appellees would have the effect of narrowing claim 9 to the same scope as claim 10, which specifies rolls, thus

destroying the well settled right of patentees to have claims of varying scope. See *Application of Lundberg*, 244 F.2d 543 (C.C.P.A. 1957).

2. Appellees Use the Individually Compacting Step.

Appellees' desire to compare the equipment used in their process with the equipment suggested by the patent is understandable in view of the evidence in the record (cited in appellant's original brief at pp. 44-48) which establishes that they are performing step 3 of claim 9.

No less a person than Mr. Williams, the man who designed and built appellees' equipment, has testified that claim 9 reads directly on the operation conducted by appellees in Los Angeles (Robert Milton Williams deposition, June 21, 1967, pp. 24-26). He was particularly emphatic on the identity of step 3 in the two processes:

"Q. And that material [the 45% which is sent through the hammer mill in appellees' step 3] that is recycled back through the hammer mill goes through the process of individual compaction and balling up of the pieces?

"A. It goes through the process of being hammer milled again, yes.

"Q. And you have agreed with me that part of that, at least, consists of compacting and balling up the individual pieces?

"A. Undoubtedly. Undoubtedly.

"Q. To further densify the material?

"A. That is correct.

"Q. While maintaining the individuality of the separate pieces?

"A. I would assume that is true.

"Q. From your experience?

"A. Yes.

"Q. Whereby fluent mass is obtained?

“A. Yes. That means it would flow. Yes, down a conveyor or something.” (Material in brackets supplied).

Since they perform every operation in the claim, appellees cannot avoid infringement merely because some subdivision of the fragments also takes place. *Neff Instrument*, supra at 89, 90.

The affidavit by Prof. Hassialis supports the inference that most of the pieces counted by him were merely small chips. By his figures, 35% of the pieces were between $\frac{1}{2}$ inch and 1 inch in their maximum dimension. There might well have been 35% more between 1 inch and $1\frac{1}{2}$ inches. If this is true there would be left only a few more than the original number of shredded pieces sent through the hammer mill in the experiment. Certainly the $\frac{1}{2}$ inch to $1\frac{1}{2}$ inch pieces are small chips compared to the 6 to 10 inch dimensions of the original pieces. A piece $1\frac{1}{2}$ inches square is only $2\frac{1}{4}\%$ of the area of a piece 10 inches square. On a weight basis, the amount of steel in the pieces under $1\frac{1}{2}$ inches would be insignificant. This affidavit is more significant in what it omits than in what it includes. It nowhere advises the court how many sizeable pieces were left or what the hammer mill did to them.

Attorneys for appellee argue that it is illogical to say a hammer mill can perform the first step of claim 9 as well as the third step. The record is clear, however, that the action of the five inch wide hammers in the hammer mill on an entire car body or stove is different from the action of those same five inch wide hammers on a malleable piece of scrap no greater than ten inches in its largest dimension. The larger the piece the more the tendency of the hammer to shred it; the smaller the piece the more the tendency to compact and ball it up (Sam Proler deposition, pp. 25, 26). A hammer mill has many

functions, depending on the type of material which is fed into it. When rocks or ore are fed into it, its function is to shatter.

The references in the evidence to a "nuggetizer" are not immaterial, as claimed by appellee. The record establishes that the "nuggetizer" used in the pilot plant operation at Williams Patent Crusher & Pulverizer Company to compact the shredded pieces was a hammer mill, (Exs. D, M) and there is no evidence that this hammer mill was specially designed. Further, Mr. Magness, the Vice President of appellee Luria in charge of this operation, equated in writing the function of the "nuggetizer" to that of the hammer mill in appellees' process when the shredded fragments are sent through it. (Ex. N.)

Appellees unreasonably argue that the language "while maintaining the individuality of the separate pieces" should be construed to exclude a process which includes some further subdivision of the shredded pieces. This language must be interpreted consistently with the intent manifested in the record before the Patent Office, i.e. to the effect that it distinguished only over the prior art bundles or bales. *U.S. v. Adams*, supra at 48, 49; *Bianchi v. Barili*, 168 F.2d 793, 799, 800 (9th Cir. 1948). At the very least, in view of the record, a fact issue is raised as to how this language in the claim should be interpreted. *Moist Cold Refrigerator Co. v. Lou Johnson Co.*, 249 F.2d 246, 255, 256 (9th Cir. 1957).

The affidavit by Prof. Hassialis certainly cannot establish conclusively that by sending shredded, malleable, steel scrap through the hammer mill in the third step of their process, appellees are merely following the prior art "closed circuit" grinding of ore and minerals. Dr. Pennington's affidavit (Ex. T) points out that none of the texts cited by Prof. Hassialis mentioned the processing of steel

scrap, "or any other material remotely similar thereto". The evidence (appellant's original brief, pp. 44-48) is to the effect that the action of a hammer mill on shredded, malleable, steel scrap is that of individual compaction of the pieces, which would be impossible to achieve on ore or minerals. Further, in none of the three texts are there any references to a method for producing a shredded product of a particular density (which is what appellees are admittedly doing in the third step of their process. [Burlingame deposition, June 1, 1966, pp. 20-22]).

The patented process is a procedure for treating a particular material in a particular manner to achieve a desired result. There is no evidence of such treatment of such material to achieve such a result in the prior art.

At the very least, therefore, a genuine issue of material fact is raised on whether appellees are merely following a prior art process.

3. Fact Issues on Infringement.

Certainly under the record in the case genuine issues of material fact are raised as follows:

a) Whether the act of running the previously shredded ferrous scrap through the appellees' hammer mill constitutes "individually compacting and balling up the pieces of the more ferrous bearing shredded material to densify it while maintaining the individuality of the separate pieces, whereby a fluent mass is obtained";

b) Whether the language in claim 9, "while maintaining the individuality of the separate pieces", was intended by the patentee to distinguish over the prior art practice of baling or was intended by the patentee to exclude subdivision of the pieces; and

c) Whether appellees are merely following the prior art process of a closed circuit grinding of ores and minerals.

C. THE REISSUE

1. Same Invention.

Appellees do not deny in their brief that the alleged defense to the effect that claim 9 is not for the invention originally disclosed raises an issue of fact. Instead they argue that "the court below was certainly far more competent than a jury to . . . determine whether . . . claim 9 is for the same invention disclosed in the original Proler patent" (p. 17 of appellees' brief).

But on a motion for summary judgment the court cannot decide any fact issues. *Poller v. Columbia Broadcasting System*, 368 U.S. 464, 468, 7 L.Ed.2d 458 (1962). Furthermore, the court may not decide fact issues on summary judgment merely because all of the evidence on such issues is in documents which are before the court. *Hycon Manufacturing Co. v. H. Koch & Sons*, 219 F.2d 353, 356 (9th Cir. 1955). Where the facts are undisputed but reasonable men might draw different conclusions from them the question is one of fact to be settled by the jury. *Gunning v. Cooley*, 281 U.S. 90, 94, 74 L.Ed. 720 (1930). It is especially necessary to be cautious in making a determination on whether the evidence raises genuine issues of material fact where a jury trial has been demanded. *Cameron v. Vancouver Plywood Corporation*, 266 F.2d 535, 540 (9th Cir. 1959).

Appellees' brief on this defense is merely an argument on the facts. They attempt to establish an analogy between the facts in this case and those in *U. S. Industrial Chemicals, Inc. v. Carbide & Carbon Chemicals Corporation*, 315 U.S. 668, 86 L.Ed. 1105 (1942), wherein summary judgment was not involved. But the facts in

the present case which they rely upon are not analogous to those considered in *U. S. Chemicals*.

The first four items enumerated by appellees on pages 42 and 43 of their brief have to do with operations which appear in the *preferred* embodiment in the original patent as well as in the reissue. It is well settled that a patentee is not limited to claiming the preferred embodiment. *Continental Paper Bag Co. v. Eastern Paper Bag Co.*, 210 U.S. 405, 418, 52 L.Ed. 1122 (1908).

In items 5 and 6 on pages 43 and 44 of appellees' brief they say that roasting was included in all the process claims in the applications and in the original Proler patent. As pointed out in *In re Wesseler*, 367 F.2d 838 (C.C.P.A. 1966), and in *In re Handel*, 312 F.2d 943 (C.C.P.A. 1963), the Court should not look to the claims to determine the right to reissue. Both of those cases discuss the fact that if an argument such as that made by appellees were accepted, the whole purpose of the reissue statute would be defeated.

Finally, appellees allege that certain arguments made during the prosecution of the original patent, before roasting had been shown to be old, are evidence that roasting was essential. Appellees would have the court ignore the fact that the record clearly shows that the arguments which induced the Examiner to allow the original patent did not even mention roasting (R. 466-473), and therefore had no effect upon the issuance of the original patent.

Appellees' arguments attempting to discount the effect of appellant's evidence are replete with erroneous statements. For example, appellees state at pp. 45, 46 that in *Monogram Mfg. Co. v. Glemby*, 136 F.2d 961 (2nd Cir. 1943), the spring was originally described as optional. This is not true. The spring was described as

optional in a prior art patent (963, 964 of 136 F.2d), but not in the patent in suit. Appellees also say that the "objects of invention" of the Proler patent are not analogous to those of *Monogram* because Proler's objects are concerned with quality, costs and characteristics of the product. The objects in the patent in *Monogram* were concerned with efficiency, easy operation, easy cleaning, long service, simplicity and low cost (963 of 136 F.2d). It is hard to see how a closer analogy could be found. On the other hand, in *U. S. Chemicals* the court noted that the objects of the invention recited the use of water, which is what was omitted in the reissue.

Every fact cited in *Monogram* on the question whether the reissue was for the invention originally disclosed exists in this case. Conversely, the facts in this case are distinguishable from the facts in *U. S. Chemicals*.

The record in this case makes it clear that there exists a genuine issue of material fact on the question whether claim 9 is for the invention originally disclosed.

2. The Reissue Error.

All of appellees' arguments on the error questions derive from a single erroneous view of the law—the meaning of the term "error without deceptive intention" in 35 U.S.C. §251. They never say what they would have the term mean, but they deny that it includes a failure of the patentee to claim as broadly as he was entitled to, as appellant asserts, and as the courts have consistently held. Note the statements of four different Courts of Appeals at pp. 69-70 of appellant's original brief. To counter this, appellees cite only *Lockwood v. Langendorf United Bakeries, Inc.*, 324 F.2d 82 (9th Cir. 1963), in which the term "error" is not defined at all, and the court expressly stated that it would not pass

on the question of whether there was error. The other cases cited give no meaning to the term different from that set forth by appellant. In fact, *Miller v. Brass Co.*, 104 U.S. 350, 26 L.Ed. 783 (1881), cited by appellees, expressly states that a failure to claim broadly enough to cover the invention is ground for a reissue.

The record contains ample evidence that the applicant Proler failed to claim as broadly as he was entitled in his original patent. Roasting was old (Brooke patent, Ex. U), and was not a factor in the allowance of the original claims, so the prior art would have permitted broader claims. No claims of the scope of the reissue claims had ever been prosecuted and abandoned. *National Nut Co. v. Sontag Chain Stores Co.*, 107 F.2d 318, 331 (9th Cir. 1939). The roasting limitation was not added to avoid the prior art. *In re Wesseler*, supra at 849.

At the very least a genuine issue of material fact is presented as to whether there was error as contemplated by the statute, and more particularly, whether the applicant Proler failed to claim as broadly as he was entitled in his original patent.

The only evidence on which appellees rely to support their view that this fact issue should be found in their favor are the arguments made by Proler's attorney during the prosecution of the applications and the fact that all the original claims included roasting. Appellees cite no authority holding that any such evidence is material to a determination of this fact issue. And the law is clear that it is not material. As stated by the court in *In re Wesseler*:

“. . . in the literal sense . . . every paper formally submitted is generally done ‘deliberately’ and with the design of advancing the prosecution so as to secure a patent. As discussed infra, that is not what

is meant by the term 'deliberate'." *In re Wesseler*, supra at 848.

The court further stated: "We find that while appellant acted 'deliberately' he did so in error." *In re Wesseler*, supra at 850.

Appellant has already pointed out in its original brief at p. 74, that the law does not require a reissue oath at all. Even the case cited by appellees, *General Radio Co. v. Allen B. DuMont Laboratories*, 129 F.2d 608, 612 (3rd Cir., 1942), acknowledges that the Commissioner of Patents may use other evidence.

However, assuming *arguendo* that the law did require that the oath fully set out the nature of the error relied on for the reissue, Sam Proler's oath (R. 495, 496) fully complied, as is noted at pp. 72, 73 of appellant's original brief. In any event, the question of whether or not the oath set out the nature of the error would certainly be a fact question, and therefore not determinable on summary judgment.

Thus, in granting summary judgment on the questions of error as a basis for the reissue, the district court necessarily decided at least the following genuine issues of material fact:

- 1) Whether it was error without deceptive intention for Sam Proler to fail to claim his invention more broadly in his original patent.
- 2) Whether the oath describes the error; and
- 3) Whether without the oath, the Commissioner had sufficient evidence before him to find error.

III.

CONCLUSION

Appellees' position that there are no fact issues in this case is certainly inconsistent with their contention before

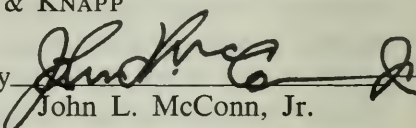
Pretrial, when they advanced 94 issues of fact, which, after several days of conference between counsel, culminated in the 34 fact issues set forth in the Pretrial Conference Order (R. 209-213).

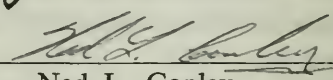
The record before this court discloses that genuine issues of material fact exist on each of the five grounds on which summary judgment was granted. The district court therefore erred, and its judgment should be reversed and remanded so that appellant may have its day in court.

Respectfully submitted,

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I certify that, in connection with the preparation of this brief, I have examined Rules 18, 19 and 39 of the United States Court of Appeals for the Ninth Circuit, and that in my opinion, the foregoing brief is in full compliance with those rules.

This is to certify that three copies of this brief have been served on counsel for the appellees by mailing them to their addresses of record.


Attorney

APPENDIX

Statutes

35 U.S.C. §112

§112. Specification

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same, and shall set forth the best mode contemplated by the inventor of carrying out his invention.

* * * * *

An element in a claim for a combination may be expressed as a means or step for performing a specified function without the recital of structure, material, or acts in support thereof, and such claim shall be construed to cover the corresponding structure, material, or acts described in the specification and equivalents thereof.

35 U.S.C. §251

§251. Reissue of defective patents

Whenever any patent is, through error without any deceptive intention, deemed wholly or partly inoperative or invalid, by reason of a defective specification or drawing, or by reason of the patentee claiming more or less than he had a right to claim in the patent, the Commissioner shall, on the surrender of such patent and the payment of the fee required by law, reissue the patent for the invention disclosed in the original patent, and in accordance with a new and amended application, for the unexpired part of the term of the original patent. No new matter shall be introduced into the application for reissue.

